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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,534	06/04/2001	Lainye Reich	10010987-1	3560

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EXAMINER
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GYORFI, THOMAS A

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/873,534

Applicant(s)

REICH ET AL.

Examiner

Tom Gyorfi

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-28 remain for examination. The correspondence filed 1/18/04 amended claims 1, 6, 7, 11, 13, 17, 21-23, and 27; and cancelled claims 29-36.

### ***Response to Arguments***

2. Applicant's arguments filed 1/18/04 have been fully considered but they are not persuasive.

3. In response to applicant's argument that the Smith reference does not teach that a document is configured for one-time use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Note that Smith dedicates a significant portion of the text (col. 7, line 37 – col. 9, line 42) to illustrating an embodiment of the invention wherein a document is configured for one-time use [by uploading to a document store for the sole purpose of transmitting to another user], is transmitted to exactly one user, and then is deleted so as to render further access of said document impossible.

4. Applicant further argues, *"It may be possible that the single-use address is temporary because the address may be deactivated in other ways besides deletion, thus the inherency does not necessarily follow. Accordingly, since it is not inherent, and other mechanisms are available, Applicants respectfully submit that a prima facie case of obviousness has not been established in the absence of documentary evidence. Certainly if it is so obvious to delete an URL, a reference can be provided to establish this assertion. Otherwise, Applicants respectfully request that the rejection be withdrawn."* This argument is deemed moot in view of Examiner's discovery of an explicit teaching within the Smith reference that the document (and thus by extension, the PURL) is deleted after transmission (col. 8, lines 40-50, and col. 9, lines 28-30).

***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-2, 4-8, 10-13, 16-18, 20-23, and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (U.S. Patent 6,192,407).

Regarding claim 1, Smith teaches a system for document retrieval that features the ability to dynamically assign a single-use document address to the requested document, receiving an access request for the Internet appliance, sending the document to the Internet appliance (column 15, lines 32-42), and deleting a single-use document address assigned to the requested document after the requested document has been sent to the Internet appliance (col. 8, lines 40-50 and col. 9, lines 28-30).

Note that a PC as illustrated by element 320 of Figure 20 is an Internet appliance under the broadest definition of the term.

Regarding claim 2, again note that the documents served by Smith's invention can be password protected (column 15, lines 46-48).

Regarding claim 4, observe that the server in Smith's invention sends an email containing the single-use URL (column 15, lines 38-41).

Regarding claim 5, it is readily apparent that the server in Smith's invention is an Internet web server computer, evidenced by its innate support of HTTP (column 5, lines 32-38) and the fact that the recipient uses the Web to access documents from it (column 15, lines 40-41)

Regarding claim 6, note that the PURL used in the invention is a uniform resource locator address (column 15, lines 8-11).

Regarding claim 7, the invention disclosed by Smith creates [returns] a temporary document address assigned to a document (column 15, lines 8-11 and 32-34), receiving the temporary document address from the remote server by communicating it to a recipient's PC [Internet appliance] by email (column 15, lines 37-40), and having the recipient's PC retrieve a document configured for one-time use by issuing a request to the remote server to retrieve a document, using the temporary document address and the Web (column 15, lines 8-11 and also lines 40-41).

Regarding claim 8, the documents can be protected by a password, which is construed to be a form of authentication information (column 15, lines 46-48).

Regarding claim 10, note that the PURL used in the invention is a uniform resource locator address (column 15, lines 8-11).

Regarding claims 11, 17, 22, and 27, the system disclosed by Smith contains the features of configuring a document for one-time use (column 15, lines 32-34), sending the single-use document address to the requesting device (column 15, lines 38-41), downloading/retrieving the document from the server [storage location] according to the single-use document address (column 15, lines 40-41), and terminating the single-use document address after downloading the retrieved document (col. 8, lines 40-50; col. 9, lines 28-30).

Examiner contends that it is inherent to using the Web, and to the HTTP protocol in particular, that by entering a [P]URL into a web browser - either by clicking a hyperlink or by manually typing it in - said web browser necessarily generates a request to the web server for the document identified by the [P]URL.

Regarding claims 12 and 20, again note that the PURL is communicated to the recipient via email (column 15, lines 38-40).

Regarding claims 13 and 23, note that the single-use document address is dynamically assigned to the retrieved document (col. 15, lines 32-34).

Regarding claims 16, 21, and 26, note that the PURL used in the invention is a uniform resource locator address (column 15, lines 8-11).

Regarding claim 18, the documents can be protected by a password (column 15, lines 46-48).

Regarding claim 28, note that the document can be encrypted according to encryption information (column 13, lines 26-30) and decrypted (column 16, lines 10-20).

***Claim Rejections - 35 USC § 103***

7. Claims 3, 9, 14-15, 19, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as applied to claims 1, 7, 11, 17, and 22 above, and further in view of Schneier ("Applied Cryptography", 2<sup>nd</sup> edition).

Regarding claims 3, 9, 14, 19, and 24, it should be noted that while the files stored on the server can be encrypted, and that decryption can be performed using a key included in the PURL (column 16, lines 10-20), Smith is unclear as to what type of encryption algorithm is employed in this feature. The only reference in Smith's disclosure refers to offering the sender a choice between "Public Encryption" and "Private Encryption", with no further clarification (Smith, column 13, lines 26-30). As found in the Schneier reference, these terms would appear to be synonymous with each other, referring to an asymmetric encryption algorithm where separate keys are used for encryption and decryption (Schneier, page 31, "2.5 Communications Using Public-Key Cryptography"). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to offer at least one symmetric encryption algorithm – one that uses the same key for both encryption and decryption (Schneier, page 28, "2.2 - Communications Using Symmetric Cryptography") as a valid choice for encrypting files on the server disclosed by Smith. As Schneier teaches, symmetric algorithms are typically better at encrypting data than public-key asymmetric algorithms, particularly as they are more efficient (Schneier, page 216, "10.2 Public-Key Cryptography vs. Symmetric Cryptography"). Consequently, in the embodiment of the invention by Smith as modified by Schneier, the decryption key communicated to the

receiver would by definition also be the encryption key for encrypting the requested document, and that the document would necessarily be encrypted according to this key.

Further regarding claims 9 and 19, in the embodiment of the invention disclosed by Smith as modified by Schneier, when the user follows the link provided by the PURL (Smith, column 16, lines 10-20), the address containing the encryption key used for encrypting the requested document (element 334 of Figure 20) will be communicated back to the server as part of the HTTP request intrinsic to accessing documents via the Web (Smith, column 15, lines 40-41).

Regarding claims 15 and 25, Smith clearly teaches that a decryption key is communicated back to the recipient, and that the document is decrypted using the decryption key (column 16, lines 10-20 and element 334 of Figure 20).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "Mapping URLs to Filesystem Locations"  
<http://httpd.apache.org/docs/urlmapping.html>, published by the Apache Software Foundation (reference date of 3/2/2001 provided by the Internet Archive at <http://www.archive.org>) teaches that URLs are effectively deleted when the source file to which they refer cannot be found.



9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:00am - 4:30pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TAG  
5/4/05



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